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P/2167-230

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of

Alexandra Keene

Date: November 29, 2001

Serial No. : 09/809,494

Group Art Unit: 2161

Filed : March 15, 2001

Examiner: Unknown

For : SYSTEM AND METHOD FOR CHECK EXCEPTION  
ITEM NOTIFICATIONAssistant Commissioner of Patents  
Washington, D.C. 20231

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Technology Center 2100

**RENEWED PETITION TO MAKE SPECIAL  
PURSUANT TO MPEP § 708.02 VIII**

Sir:

In response to the Decision On Petition to Make Special ("Decision") mailed on October 1, 2001, Applicant submits this Renewed Petition to Make Special in order to perfect any possible defects existing in the Petition to Make Special filed with the above-referenced application on March 15, 2001 ("Original Petition").

The Decision indicated that the Original Petition was defective for two reasons:

1. There was no statement in the Original Petition asserting that all of the claims presented are directed toward a single invention.
2. There is no discussion of how independent claims 23 and 25 are not disclosed by the cited references.

With respect to the first asserted defect, Applicant respectfully asserts that it is not necessary to affirmatively state that all the pending claims are directed toward a single invention. The applicable M.P.E.P. section merely states (M.P.E.P. § 708.02) that the claims are to be directed to a single invention but does not require that the Petitioner affirmatively assert that the claims are actually directed towards a single invention. Moreover, the rules set forth a disjunctive. That is,

Applicant must comply with: "(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status" (emphasis added). In this case, Applicant specifically indicated in the Original Petition that Applicant would make such an election without traverse. Applicant renews this offer in the present Renewed Petition.

With respect to the second asserted defect, in the Declaration in Support of the Original Petition ("Original Declaration") Applicant referenced elements in independent claim 23 which are not shown in the cited references. Specifically, the Original Declaration at the end of paragraph 7 stated: "Nor does the prior art disclose or suggest an electronic mail including information relating to an exception item as is required by independent claim 23 of the present invention." Additionally, independent claim 25 also recites an electronic mail including such information. Thus, Applicant implicitly referenced elements in independent claim 25 which are not disclosed in the prior art. The attached Declaration of Steven S. Rubin In Support of Renewed Petition to Make Special more completely and affirmatively recites these elements in claims 23 and 25 which are not show in the prior art.

Applicant, therefore, through her undersigned representative, again hereby petitions, pursuant to 37 C.F.R. § 1.102(d) and MPEP § 708.02 VIII, that the present application, be made special.

In support of this Petition, Applicant submits a new Declaration by Steven S. Rubin reporting a search for prior art. Copies of these prior art references were furnished with the Original Petition.

Mr. Rubin's report on the search for the prior art describes the field of search by class and subclass, and includes a detailed discussion of the references, including how the invention is distinguishable from the references with the particularly required by 37 C.F.R. §1.111(b) and (c).

If the Patent and Trademark Office determines that all claims presented are not directed to a single invention, Applicant will make an election of a single invention without traverse.

Grant of the Petition is earnestly solicited.

In the event the actual fee is greater than the payment submitted or is inadvertently not enclosed, or if any additional fee during the prosecution of this case is not paid, the Patent and Trademark Office is authorized to charge the underpayment to Deposit Account No. 15-0700.

MAIL CERTIFICATE

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, on November 29, 2001:

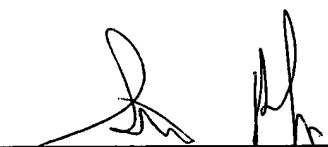
\_\_\_\_\_  
Steven S. Rubin  
Name of Person Mailing Correspondence

\_\_\_\_\_  
Signature

\_\_\_\_\_  
November 29, 2001  
Date of Signature

SIW:SSR:mcm

Respectfully submitted,

\_\_\_\_\_  
  
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DECLARATION OF STEVEN S. RUBIN  
IN SUPPORT OF RENEWED  
PETITION TO MAKE SPECIAL

Steven S. Rubin declares:

1. I am registered to practice before the U.S. Patent and Trademark Office, Registration No. 43,063, and am one of the individuals who is empowered to act in the above application.

2. My declaration is made in support of the Applicant's Renewed Petition to Make Special the present application pursuant to 37 C.F.R. § 1.102 and MPEP 708.02 VIII.

3. The present application is directed toward an improved system and method for notifying a client of an exception item. A payor writes a check to a payee. The payee presents the check to the payee's bank. The payee's bank, in turn, presents that check to the payor's bank. Some payor banks provide a check exception item processing service in which the bank compares checks presented by payee banks to a list of checks written by the payor. If any checks do not match, an exception item is created. The

system and method of the invention creates a web file and corresponding unique uniform resources locator ("URL") for each payor client for the exception items. The URL is sent to the client via an electronic mail so that client may access the web page associated with the URL and quickly authorize or decline payment for the exception item.

4. An Information Disclosure Statement listing at least each of the references cited herein along with copies of those references was submitted with a previous Declaration filed on March 15, 2001.

5. I commissioned a search of pertinent prior art by engaging the patent search firm of Lacasse & Associates, 2001 Jefferson Davis Highway, Suite 806, Arlington, Virginia 22202. A manual search in the public search room of the U.S. Patent and Trademark Office was performed among the references classified in at least Class 235, subclasses 375 and 379; and Class 705, subclasses 27, 30, 35, 38, 39, 40, 42, 44, 45 and 75. Computer searching using, for example, using key words in the U.S. Patent and Trademark Office Automated Patent System was performed to augment the manual search.

6. Of the references cited in the above-identified applications or located during the search described above, the following are deemed the most relevant to the present application.

U.S. Patent 5,373,550 to Campbell et al. shows a system for transferring an image of a check from one banking institution to another to facilitate and expedite payment of the check. The system shown in Campbell et al. does not provide exception item notification at all but merely sends an image of a presented check to a payor bank quickly. The payor bank is then required to determine whether the presented check corresponds to a check issued by the payor bank. There is no disclosure for how exception clients are notified of exception items by the payor bank. Nor is there disclosure for the use of an electronic mail to provide notification of such exception items or for an electronic mail including a link to information regarding an exception item.

U.S. Patent 5,691,524 to Josephson shows a system for expediting the flow of data relating to checks presented between partner banks. Although exception items are determined, the focus is on how information relating to such items may be conveyed between a payor bank and a payee bank. There is no disclosure for how clients are notified of such exception items by the payor bank. Nor is there disclosure for an electronic mail including a notification of an exception item or for an electronic mail including a link to information regarding an exception item.

U.S. patent 5,819,236 to Josephson shows a system where a restricted account file is received by an intermediary entity from participating financial institutions. The intermediary entity matches presented checks with the restricted account file to determine whether the presented checks should be cashed. Again, there is no disclosure relating to notifying clients of a payor bank of exception items via electronic mail. There is also no disclosure for an electronic mail including such information or for an electronic mail including a link to information regarding an exception item.

U.S. Patent 5,848,400 to Chang shows a system for quickly settling transactions between financial institutions. There is no disclosure for notifying a client of the financial institution of an exception item. There is also no disclosure for an electronic mail including such information or for an electronic mail including a link to information regarding an exception item.

U.S. Patent 5,895,455 to Bellinger et al. relates to a system for processing, imaging, and cataloging a large amount of issued checks. These images can be used to detect an exception item. Further, the images themselves may be sent to a client electronically. However, there is no disclosure for sending a notice regarding such an exception item to a client of the payor bank. Nor is there disclosure for an electronic mail which includes exception information or for an electronic mail including a link to information regarding an exception item.

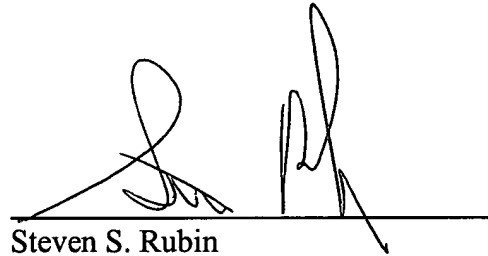
U.S. Patent 5,940,844 to Cahill et al. discusses another system for processing, imaging, and cataloging a large amount of issued checks. These images can be made available to a user through a network. The system does not determine exception items nor does it disclose an electronic mail which includes exception information or an electronic mail including a link to information regarding an exception item.

7. The prior art, taken alone or in combination, does not disclose the unique combination of elements recited in the claims of the present application. Specifically, none of the references, alone or in combination, disclose or suggest determining exception items and then notifying clients of a payor bank of those exception items via an electronic mail as is explicitly required by independent claims 1, 10, 11, 18, 19 and 21 of the present application. The prior art does not disclose or suggest an electronic mail including information relating to an exception item as is required by independent claim 23 of the present invention. Finally, the prior art does not show an electronic mail including a link to information regarding an exception item which is required by independent claim 25 of the present invention.

8. Based upon the foregoing observations about the prior art, it is my opinion that the claims in the present application are allowable over the prior art.

9. I further declare that all statements made herein of my own knowledge are true, except for those statements made on information and belief, which are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this declaration, this application and any patent resulting therefrom.

Dated: November 29, 2001



Steven S. Rubin

MJS:SSR:mcm